

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
David A. Russo et al.)
Serial No.: 08/544,212)
(Original Patent 5,401,305 issued)
March 28, 1995, Original Serial)
No. 104,125 filed December 13, 1993)
Filed: October 17, 1995)
For: COATING COMPOSITION FOR GLASS)
Owner of Record: Elf Atochem North)
America, Inc.)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

DECLARATION OF STANLEY A. MARCUS

I, Stanley A. Marcus, declare and state as follows:

1. I am Patent Counsel for the assignee of the above-identified patent and reissue application, Elf Atochem North America, Inc., and was one of the attorneys appointed by David A. Russo, Ryan R. Dirkx, and Glen P. Florczak to prosecute the application leading to Patent No. 5,401,305 ("the '305 patent").

2. During the Summer of 1995, I was comparing the claims of the '305 with another patent for interference purposes. I became aware that the claims of the '305 patent claimed less than Messrs. Russo, Dirkx, and Florczak had a right to claim as inventors. In my opinion, as a result, the '305 patent is partially inoperative through this error.

3. This misunderstanding regarding the scope of the Russo et al. invention (i.e., the error) arose when I had a meeting with Atochem's Research and Development people to discuss the claims of the '305 patent as issued. Upon this review, I discovered that the claims claimed less of the invention as disclosed in the specification of the '305 patent. In particular, the claims of the '305 patent relate to a gaseous composition adapted to deposit at least a first layer of tin oxide and silicon oxide onto glass at a rate of deposition greater than about 350 Å/seconds, wherein the composition comprises a precursor of tin oxide, a precursor of silicon oxide or formula $R_mO_nSi_p$, an accelerant selected from the group consisting of organic phosphites, organic borates, and water and mixtures thereof, and a source of oxygen. The claims as presented in the amendment attached to the Russo et al. Declaration are different in that they relate to a gaseous mixture comprising at least one metal oxide precursor and an accelerant, a film comprising at least one metal oxide and an accelerant, and also relate to a layer comprising at least one metal oxide and an accelerant deposited on a substrate.


4. The misunderstanding or error arising from the scope of Russo et al.'s invention occurred without any deceptive intention on the part of the applicant, assignee, or applicant's counsel.

5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

January 5, 1996


Stanley A. Marcus